

REMARKS

The present Amendment responds to the Office Action dated July 21, 2006 having a shortened statutory period for response set to expire October 21, 2006. Filed concurrently herewith is a request for a three (3) month extension of time to respond, making the present Amendment due by January 21, 2007, which is a Sunday, such that the present Amendment is timely if filed by January 22, 2007.

In the Office Action, claims 1-7 were pending. The Examiner maintains her previous rejections of the claims under 35 U.S.C. § 112, first paragraph. In addition, the Examiner rejected the claims under 35 U.S.C. § 103(a) over WO 99/47525 to Mühlebach et al. While Applicants continue to disagree with the Examiner's § 112 rejection, Applicants have amended claim 1 for the Examiner's consideration. Applicants' submit that the present specification, along with the five (5) Declarations submitted pursuant to 37 C.F.R. § 1.132, clearly and adequately enable one ordinary skilled in the art how to practice the full scope of the claimed invention.

As the Examiner will note, the herbicidal composition currently claimed in amended claim 1 is comprised of a selected compound of formula I and at least one co-herbicide selected from 9 (nine) herbicide classes. The Examiner may appreciate that amended claim 1 is significantly narrower in scope than as originally filed. Indeed, the compound of formula (I) now recited has the general structure represented as (Ie) in Applicants' specification. Applicants' specification provides numerous examples of compounds having the general structure of formula (Ie). These examples can be found in Applicants' specification, for example, in Table 1 located on pages 25-30.¹

The nine (9) co-herbicide classes remaining in amended claim 1, and the increased herbicidal action exhibited by these co-herbicides in combination with the selected compound of formula (I), is clearly enabled by Applicants' specification. Applicants have at, a minimum, illustrated a representative sample of the selective herbicidal action of the compound of formula I and each of the nine (9) herbicide classes. Reference is made to pages 39-45 of the present specification, as well as the five (5) 1.132 Declarations of Jutta Glock submitted in response to the Office Action dated February 23, 2005. Particularly, the specification and the Declarations demonstrate the herbicidal action of over 30 different compositions comprised of a selected compound of formula (I) and a selected co-herbicide. Specifically, the Examiner's attention is directed to all five (5) of the 1.132 Glock Declarations and pages 40-44 of the present specification wherein the synergism is demonstrated between a selected compound of formula (Ie) and the following members of the nine (9) co-herbicide classes listed below:

¹ The page numbers referenced correlate to the pagination of WO 01/17351

I. Phenoxypropionic Acids:

- *Clodinafop-P-propargyl*
- *Fenoxaprop-ethyl*

II. Hydroxylamines

- *Tralkoxydim*

III. Sulfonylureas

- *Triasulfuron*
- *Amidosulfuron*
- *Tribenuron*
- *Idosulfuron*
- *Thifensulfuron-methyl*
- *Metsulfuron*
- *Flupyrasulfuron*
- *Sulfosulfuron*

IV. Phenoxyacetic Acids

- *Mecoprop*
- *Fluroxypyr*
- *MCPA*
- *2,4-D ester*
- *2,4-D amine*

V. Thiolcarbamates

- *Triallate*
- *Prosulfocarb*

VI. Benzoic Acids

- *Dicamba*

VII. Anilides

- *Diflufenican*

VIII. Nitriles

- *Bromoxynil*
- *loxylinil*

IX. Sulfonamides

- *Florasulam*
- *Flucarbazone*
- *Propoxycarbazone*
- *Metosulam*

Applicants respectfully submit that they have provided a sufficient number of representative examples such that one of skill in the art would expect that any select compound of formula (I) and second herbicide as claimed would be expected to perform in the same manner without undue experimentation. To argue the contrary will require more than a general allegation that Applicants' disclosure would have not taught one skilled in the art how to make and use the full scope of the claimed invention. Indeed, as provided in MPEP § 2164.03, "[p]roof of enablement will be required for other members of the claimed genus *only where adequate reasons* are advanced by the examiner to establish that a person skilled in the art could not use the genus as a whole without undue experimentation." (MPEP § 2164.03, p. 2100-196).

In addition to the foregoing, the Examiner will note that Applicants have added new dependent claims 8-16. These dependent claims specifically recite respective members of each of the nine (9) co-herbicide classes for which specific representative examples are described by the present specification and further by the five (5) 1.132 Glock Declarations.

Finally, with respect to the Examiner's § 103(a) rejection of the claims, Applicants respectfully maintain that WO 99/47525 to Mühlebach et al. is not prior art under 103(a)/102(e), (f), or (g). Applicants Remarks presented in the Amendment filed January 4, 2005, which address this reference, are incorporated herein by reference.

Based upon the foregoing then, Applicants submit that the pending claims are in condition for allowance and the Examiner is courteously solicited to pass this application on to allowance. No other fees are believed to be payable at this time. However, the Commissioner is authorized to debit any applicable fees from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-6049

/Rebecca A. Gegick/
Rebecca A. Gegick
Attorney for Applicants
Reg. No. 51,724

Date: January 22, 2007